

REMARKS

Prior to the present amendment, claims 3-18 were pending in the application. Claims 8-18 were withdrawn and claims 3-7 have been rejected. After entry of this Amendment, claims 3-7, 16, 17 and 19-29 are pending.

It is respectfully submitted that claims 16 and 17 are dependent claims drawn to the method of claim 3, and therefore should be considered with the other elected method claims.

Amendments

In the Specification

The tables on pages 8, 9 and 10 have been amended to correct the obvious error "Popylparaben" to --Propylparaben--.

In the Claims

Claim 3 has been amended to require that the composition is substantially free of potent tyrosinase inhibitors. This amendment is supported by the disclosure at instant paragraph [0034] of the USPTO published present application, and also supported by the Examples that describe compositions that are substantially free of potent tyrosinase inhibitors. The present specification identifies the incorporation of potent tyrosinase inhibitors as disadvantageous because such agents exhibit adverse side effects. See paragraph [0035]. The specification therefore provides ample support for exclusion of these agents in compositions for use in a method for depigmentation of human skin as presently claimed.

Claim 4 has been amended to delete the parenthetical expressions "(milk)" and "(lotion)."

Claim 7 has been amended to delete the term "prevention."

Claims 8-15 have been cancelled to expedite prosecution.

New claim 19 is drawn to a method for depigmentation of human skin comprising the application of a cosmetic composition to said skin, wherein said composition comprises a depigmenting agent consisting of a depigmenting effective amount of an extract of *Bellis perennis* L.. This method, therefore, is drawn to the method where the composition contains only one active depigmenting agent, which is an extract of *Bellis perennis* L.. This claim is supported by the present specification, particularly at paragraphs [0036]-[0038], which describe the

effectiveness of compositions where the only active depigmenting agent is an extract of *Bellis perennis* L.. Additional support for this claim is provided by the Examples, that describe compositions where the only active depigmenting agent is an extract of *Bellis perennis* L..

New claims 20-25 find support in originally presented claims 4-7, 16 and 17, respectively.

New claims 26-29 describe compositions wherein high molecular components of the extract of *Bellis perennis* L have been removed to provide an upper MW cut-off of 100 or 500 kDa. These compositions have been found to be particularly advantageous in use for depigmentation of human skin, and are supported at paragraphs [0032] and [0052].

Discussion

Oath/Declaration

The oath or declaration is stated to be defective because it does not identify the city, state or foreign country of residence of each inventor.

This objection is not understood. It is respectfully submitted that the declaration does provide this information. Note that, per the declaration, Inventor Sabrina John resides in Berlin, Germany.

Specification

The specification has been objected to because the specification does not contain a brief description of the drawings.

The present application was filed with a Preliminary Amendment that made numerous changes to the specification and claims in the form of a substitute specification. The substitute specification provides a brief description of the drawings. See the Unmarked Substitute Specification at page 3. Please additionally note that the published version of this US patent application provides this brief description of the drawings at paragraphs [0011]-[0014].

Claim Rejections – 35 USC § 112

Claim 7 has been rejected under 35 U.S.C. 112, first paragraph, stating that because the specification, while being enabling for treatment and reduction of hyperpigmentation or hypopigmentation, does not reasonably provide enablement for prevention of hyperpigmentation or hypopigmentation.

The term “prevention” has been deleted from the claim, thereby obviating this rejection.

Claim 4 has been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim was rejected for use of parentheses. All parenthetical expressions have been deleted from the claim, thereby obviating this rejection.

The claim was also rejected for the use of the term “tenside.” It is respectfully submitted that the term “tenside” is an alternative term for “surfactant,” and therefore this use is proper.

Claim Rejections – 35 USC § 102

Claims 3-5 have been rejected under 35 U.S.C. 102(b) as being anticipated by JP 07025762 (“JP ‘762” - English translation provided).

The present claims as amended are drawn in one aspect (amended claim 3) to a method for depigmentation of human skin comprising the application of a cosmetic composition to said skin, wherein said composition comprises a depigmenting effective amount of an extract of *Bellis perennis* L., and wherein the composition is substantially free of potent tyrosinase inhibitors. The present specification identifies the incorporation of potent tyrosinase inhibitors as disadvantageous because such agents exhibit adverse side effects. See paragraph [0035]. In another aspect (claim 19), the method is used compositions containing only one active depigmenting agent, which is an extract of *Bellis perennis* L..

JP ‘762 describes synergistic skin external preparations containing kojic acid or its derivative and the extract of specific vegetation. A large number of extracts are listed at paragraphs [0012] - [0031] of the cited translation of this document. One of these extract sources is the daisy (*Bellis perennis*). See paragraph [0025]. All of the JP ‘762 compositions must have

kojic acid or its derivative. The combination of kojic acid or its derivative and the extract of specific vegetation is stated to provide a synergetic effect at, e.g. paragraphs [0007] and [0045]. Kojic acid or its derivative is thus an essential component of the JP '762 compositions.

Kojic acid or its derivative is known to be a depigmenting agent that is a strong tyrosinase inhibitor. See, e.g. US Patent No. 5,486,624 at column 1, lines 12-16.

The present claims expressly exclude kojic acid or its derivative, and therefore are not anticipated by JP '762. Withdrawal of this rejection is therefore respectfully requested.

Claim Rejections – 35 USC § 103

Claims 3, 4, 6, and 7 have been rejected under 35 U.S.C. 103(a) as being unpatentable over JP 07025762.

As stated above, the present claims expressly exclude kojic acid or its derivative, and therefore are not anticipated by JP '762. The skilled artisan would have had no reason to modify the composition of JP '762 to exclude an essential ingredient required to achieve synergy, and then to select one of a large number of alternative extracts of vegetation as disclosed therein to carry out the presently claimed method.

It is therefore respectfully submitted that the present claims are not obvious in view of JP '762. Withdrawal of this rejection is therefore respectfully requested.

Claims 3 and 7 have been rejected under 35 U.S.C. 103(a) as being unpatentable over JP 07025762 in view of Charpin (U.S. 5,164,185).

Charpin disclosed depigmentation compositions comprising caffeic acid as an essential ingredient, and does not disclose use of an extract of *Bellis perennis* L. at all.

The Office Action states that Charpin is cited for its teaching that it was known at the time of the invention to use depigmenting agents to treat hypopigmentation. However, the skilled artisan would have had no reason to formulate the compositions as presently set forth in the claims to carry out any method in view of JP '762 in combination with Charpin. Rather, these references in combination would have required the use of kojic acid or its derivative in any composition, which is expressly excluded from the present claims.

It is therefore respectfully submitted that the present claims are not obvious in view of JP '762 in combination with Charpin. Withdrawal of this rejection is therefore respectfully requested.

It is respectfully submitted that new claims 26-29 are particularly distinguished from the cited art. These new claims describe compositions wherein high molecular components of the extract of *Bellis perennis L* have been removed to provide an upper MW cut-off of 100 or 500 kDa. These compositions have been found to be particularly advantageous in use for depigmentation of human skin. The skilled artisan would have had no motivation to select the use of these specific fractions of *Bellis perennis L* extract, and would not have predicted that selection of such fractions would provide superior performance for methods of depigmentation of human skin.

Conclusion

In view of the above amendments, it is respectfully submitted that the present claims are now in condition for allowance. Early favorable notice to that effect is now earnestly solicited. In the event that a phone conference between the Examiner and the Applicant's undersigned attorney would help resolve any issues in the application, the Examiner is invited to contact said attorney at (651) 275-9811.

Respectfully Submitted,

By: 

Dale A. Bjorkman, Reg. No. 33,084
Customer No. 33072
Phone: 651-275-9811
Fax: 651-351-2954

Date: August 12, 2008